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| 09/536,273 | 03/27/2000 | Steven B. Smith | 13660.6 | 3734 |
| 21999 7590 04/01/2009 KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111 | | | | |
| EXAMINER | | | | |
| ADE, OGER GARCIA | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/536,273

Applicant(s)

SMITH, STEVEN B.

Examiner

GARCIA ADE

Art Unit

3687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on **12.09.2008** has been considered. Applicant amended claims 28 and 30.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claims 28-30** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 9 of U.S. Patent No. 6,487,540. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 28-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson [US 6,535,726], in view of Pare, Jr. et al. [US 6,269,348], and further in view of Examiner's Official Notice.

As per claims 28-30, Johnson discloses a system for obtaining and storing an electronic receipt use in a wireless purchaser communications device [see figure 2A, read as ***fuel dispenser 220***], the system comprising:

a credit card or debit card authorization processor [via IKD 130n and see figure 2A: **block 140**]; configured to communicate directly with a vendor to receive requests for authorization and to transmit sales authorization to a vendor [see figure 1A, read as site **communications interface 186** for communicating with other on-site systems];

a vendor device for short range transmission to a customer of initial information regarding inventory and pricing, and vendor identification, and long range transmission of requests for authorization directly to the card authorization processor and said vendor device then receiving from the credit card authorization processor sales authorization [see figure 1A, read as an outside **communications interface 182** for communicating with the supporting cellular network 160];

a purchaser device utilizing an a short range communications to communicate with the vendor device [see column 8: lines 39-53], the purchaser device being configured to transmit sales amount request, and request to purchaser, and after a sale has occurred and authorization received from the credit card and authorization processor: receiving sales information, authorization validations and receipt information from the vendor device [see column 4: lines 11 – 19 (e.g. retail site **identification**)], and see paragraph bridging columns 7 and 8 (e.g. **amount or a cost of the fuel dispensed**)].

Johnson discloses all the elements per claimed invention as mention above. Johnson does not explicitly disclose a biometric input device for user identification, which allows the purchaser to request authorization for a purchase. However, Pare discloses a biometric transaction system. Pare also discloses the authorization is

transmitted to the vendor for the purchase of an item. It should also be noted Pare discloses a biometric input device [see abstract and summary of the invention].

Therefore, it would have been obvious to one of ordinary art at the time of the invention was made to modify Johnson to include Pare biometric transaction system. Such motivation to Johnson would have been to provide greater security against fraud for the purchaser.

The above combination does not explicitly disclose a long range transmission. However, the Examiner takes Official Notice that it was well know in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the above combination for using a customer device for long range transmission to a customer of information regarding inventory pricing.

Response to Arguments

6. Applicant's arguments filed on **12.09.2008** have been fully considered but they are not persuasive.

Applicant argues that the Johnson reference does not disclose "a purchaser device . . . utilizing short range communications to communicate with the vendor device, the purchaser device being configured to transmit sale amount requests and requests to purchase, and after a sale has occurred and authorization is received from the authorization processor, receiving sales information, authorization validation and receipt information from the vendor device."

The Examiner respectfully disagrees. Johnson discloses a transaction system that provides enhanced customer convenience and increased transaction security by sending transaction information to a cellular network provider via a customer's digital cellular phone. For example, a fuel dispenser is equipped with a communications link allowing direct communications to a customer's cellular phone. This information is used by the network to authorize a purchase transaction for the customer, such authorization information returned to the fueling station at which the fuel dispenser is located via the same link [see abstract, and see the above rejection regarding the Official Notice].

Johnson further discloses a customer's cellular telephone for completing a purchase transaction. The Examiner interprets "*customer's cellular telephone*" as a "*purchaser device*" for completing a purchase transaction. Johnson further discloses that transactions based on cellular communications can provide enhanced security if the cellular phone employs secure digital signaling protocols to communicate with its supporting cellular network.

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the references are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. It is

necessary to consider the reality of the circumstances, in other words, common sense in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. In re Wood, 599 F.2d 1032, 1036, (C.C.P.A. 1979). A reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as basics of rejection. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately. The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

Applicant's arguments having been found unpersuasive, the rejection has not been withdrawn.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARCIA ADE whose telephone number is (571)272-5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571.272.3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Art Unit: 3687

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/
Supervisory Patent Examiner, Art Unit 3687

Garcia Ade
Examiner
Art Unit 3687

ga